



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,960	02/04/2002	Ross Rabin	NEX83/D	5849
25871	7590	04/18/2005	EXAMINER	
SWANSON & BRATSCHUN L.L.C. 1745 SHEA CENTER DRIVE SUITE 330 HIGHLANDS RANCH, CO 80129			BOWMAN, AMY HUDSON	
			ART UNIT	PAPER NUMBER
			1635	

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,960

Applicant(s)

RABIN ET AL.

Examiner

Amy H. Bowman

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 1-28 and 32-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Status of Application/Amendment/Claims

Applicant's response filed 3/28/2005 has been considered. Rejections and/or objections not reiterated from the previous office action mailed 12/28/2004 are hereby withdrawn. The following rejections and/or objections are either newly applied or are reiterated and are the only rejections and/or objections presently applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-28 and 32-44 are withdrawn from consideration, as being drawn to non-elected inventions.

Response to Arguments--IDS

Reference AAC (Tucker et al. (Sept. 1999) J. of Chromatography 732:202-212) from PTO form 1449 filed on 2/4/2002 has now been supplied by applicant and has been considered.

Response to Arguments--Priority

As explained in the office action mailed 12/28/2004 and reiterated herein, this application is a division of 09/364,539 with an effective date of 7/29/99. Application 09/364,539 is a continuation in part of application 09/502,344. The instant application does not receive benefit of 09/502,344 because 09/502,344 discloses the method but does disclose the instantly claimed target, c-met.

Art Unit: 1635

Applicant argues that one skilled in the art would be well aware that the c-met proto-oncogene product is a mammalian receptor, specifically a receptor tyrosine kinase and 09/502,344 (now U.S. Patent 6,331,398) discloses that the SELEX method may be used to generate nucleic acid ligands to a wide variety of proteins. However, nothing about the genus of mammalian receptors would lead one of ordinary skill in the art to the nonobvious species of c-met. Applicant has not pointed to any direct or indirect support that would lead one to this specific target. Therefore, the instant application has received priority benefit to 7/29/99, the filing date of 09/364,539.

Response to Arguments—35 U.S.C. 103(a)

Claims 29-31 were rejected under 35 U.S.C. 103(a) in the office action mailed 12/28/2004. Applicant argues that Gold et al. is not a proper prior art reference in view of the June 11, 1990 effective filing date of the application. However, this rejection is maintained due to lack of priority of the instant application, as explained above. Applicants provide no other arguments as to address the merits of this rejection.

Response to Arguments—Double Patenting

Claims 29-31 were rejected under the judicially created doctrine of obvious-type double patenting in the office action mailed 12/28/2004. This rejection is withdrawn in view of the terminal disclaimer filed by applicant on 3/28/2005 and accepted by the office on 4/8/2005.

Art Unit: 1635

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy H. Bowman whose telephone number is 571-272-0755. The examiner can normally be reached on Mon-Fri 7:30 am – 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC)

Art Unit: 1635

for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Amy H. Bowman
Examiner
Art Unit 1635



ANDREW WANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600